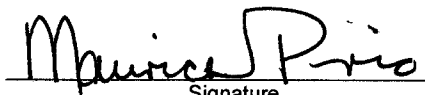


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 249768013US	
	Application Number 09/280,292-Conf. #5547	Filed March 29, 1999	
	First Named Inventor Roseman et al.		
	Art Unit 3693	Examiner R. C. Weisberger	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,273</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 50%; text-align: center;">  Signature <hr/> Maurice J. Pirio Typed or printed name <hr/> (206) 359-8000 Telephone number <hr/> July 3, 2007 Date </div> </div>			

Docket No.: 249768013US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Roseman et al.

Application No.: 09/280,292

Confirmation No.: 5547

Filed: March 29, 1999

Art Unit: 3693

For: METHOD AND SYSTEM FOR
AUTHENTICATING USERS WHEN
CONDUCTING COMMERCIAL
TRANSACTIONS USING A COMPUTER

Examiner: R. C. Weisberger

ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant is filing a Notice of Appeal and Pre-Appeal Brief Request for Review.

The Examiner has rejected claims 44-59, 71-75¹, and 122-139 under 35 U.S.C. § 112, first paragraph, based on enablement and under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner bears the initial burden of setting forth a reasonable basis for rejecting the claims under Section 112. See, *In re Wright*, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Because none of these claims includes either the language that the Examiner believes is not enabled or the language that the Examiner believes is indefinite, the rejection is improper. Moreover, the Examiner has not even established a *prima facie* case that the claims are either not enabled or indefinite.

Overview of Applicant's Techniques

Applicants' techniques generally relate to conducting auctions using a computer system. More specifically, applicant's techniques facilitate the placing of a bid at an auction. (Specification, 7:14-16.) For example, one technique displays a description of an item and requests a user to place a bid. (Specification, 7:20-21.) When the user requests to submit a bid by, for example, clicking a button that is associated with a bid amount, the technique sends the request to an auction system. (Specification, 8:1-4.) The request may include automatic authentication information (e.g., cookie information) identifying the user. (Specification, 8:4-7 and 12-14.) When the auction system receives the request, it determines whether the user can be authenticated (e.g., based on the cookie information). (Specification, 8:4-6.) If so, then the bid is placed on behalf of the user. (Specification, 8:5-7.) If not, the auction system then requests manual authentication information from the user. (Specification, 8:22-23.) When the auction system receives the manual authentication information, it places the bid on behalf of the user. (Specification, 9:16-18.)

This technique simplifies the bidding process for users who are registered to place bids and, consequently, do not need to enter authentication information. The technique also defers the entry of authentication information for users who are not registered until

¹ The Examiner has failed to mention pending claims 76-85 in the Office Action of January 3, 2007. For purposes of these pre-appeal brief arguments, applicant will assume that the Examiner intended to reject these claims for the same reasons as the other pending claims.

after the user requests to place a bid. (Specification, 9:12-16.) An unregistered user who requests to place a bid and then, for example, is told that his or her bid will be the highest may be more likely to then provide his or her authentication information, than an unregistered user who is required to provide his or her authentication information before or at the same time a bid is placed. (Specification, 9:18-24.) The deferral of authentication also allows the same user interface to be used when a user requests to place a bid regardless of whether or not the user is registered. (Specification, 9:4-7.)

35 U.S.C. § 112, First Paragraph, Rejection

The Examiner has rejected claims 44-59, 71-75, and 122-139 under 35 U.S.C. § 112, first paragraph, based on enablement. It is the Examiner's position that

the specification, while being enabling for a routine wherein the routine receives an indication that the buyer has submitted the bid, the routine determines whether the auction system can recognize the buyer, does not reasonably provide enablement for a [sic] when the routing [sic] receives an indication **without a bid**.

(Office Action, Jan. 3, 2007, p. 2, emphasis in original.)

None of the rejected claims recites receiving an indication "without a bid." As such, applicant respectfully submits that this rejection is improper because basing an enablement rejection on claim language that is not in the claims cannot be considered a reasonable basis for the rejection. Moreover, the rejection does not satisfy the requirement that applicant be given "such information and references as may be useful in judging of the propriety of continuing the prosecution of his application." (35 U.S.C. § 132(a) and 37 C.F.R. § 1.104(a)(2).) Clearly, an explanation of an enablement rejection based on language and/or a feature that is not in the rejected claims is not useful in judging the propriety of continuing the prosecution of this application.

It is possible that the Examiner may be confused with one alternative embodiment of applicant's techniques in which a user is allowed "to submit a bid"... "without entry of any bid amount." (Specification, 5:26-6:4.) In particular, a user may be presented with a

"suggested bid amount" and the user can request that a bid be submitted at the suggested amount without having to explicitly enter a bid amount.

However, the submitting of a bid "without entry of any bid amount," while fully enabled by the specification, is not recited in any of the rejected claims. Such submission of a bid without entry of a bid amount is illustrated in Figure 3 and described in the accompanying text at 14:7-22. "This display, however, also contains a suggested bid field 306 and a submit bid at suggested price button 307....The buyer can submit a bid at the suggested price by clicking on the submit bid at suggested price button." (Specification, 14:9-14.) Figure 9 and accompanying text at 20:22-21:10 further describes the setting of the bid amount to the suggested bid amount when the buyer selects the submit bid at suggested price button.

Finally, some of the claims (e.g., claim 50) recite "sending to the user a display description identifying the item to be auctioned and for requesting to submit a bid at a suggested bid amount for the item." None of the rejected claims, however, recites submitting a bid "without entry of any bid amount."

35 U.S.C. § 112, Second Paragraph, Rejection

The Examiner has also rejected claims 44-59, 71-75, and 122-139 under 35 U.S.C. § 112, second paragraph, as being indefinite. It is the Examiner's position that

In the claims "an indication to place a bid" is vague and indefinite. Is an indication also the bid?

(Office Action, Jan. 3, 2007, p. 2.)

None of the rejected claims recites "an indication to place a bid." As such, applicant respectfully submits that this rejection is improper because basing an indefiniteness rejection on claim language that is not in the claims cannot be considered a reasonable basis for the rejection. Moreover, the rejection does not satisfy the requirement that applicant be given "such information and references as may be useful in judging of the

propriety of continuing the prosecution of his application." (35 U.S.C. § 132(a) and 37 C.F.R. § 1.104(a)(2).) Clearly, an explanation for an indefiniteness rejection based on language that is not in the claims is not useful in judging the propriety of continuing the prosecution of this application.

Although the claims do not recite "an indication to place a bid," they do recite "a request to submit a bid." The specification describes that when a buyer selects a submit bid button, a notification that the user is submitting a bid is sent to the server. (Specification, Figure 1.) As is well-known in the art and described in the specification, when a link on a web page (e.g., a submit bid button) is selected a request is sent to a server. (Specification, 1:23-2:13.) Thus, when the submit bid button is selected, "a request to submit a bid" as recited by the claims is sent. One skilled in the art would clearly understand what is meant by "receiving from a user a request to submit a bid for the item" as recited for example in claim 44.

Conclusion

The Examiner's rejections of the claims are based on language that is not recited in the claims. Thus, the Examiner has not provided a reasonable basis for the rejections and has not established a *prima facie* case of nonenablement or indefiniteness. Accordingly, applicant submits that the claims are allowable and requests withdrawal of the rejections.

Dated: 1-3-07

Respectfully submitted,

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